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MATTER	18202.0002U1		
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Per the telephone message RE: Appl. No. 10/582,445
Client Matter 18202.0002U1
Draft Response for your review

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ATTORNEY DOCKET NO. 18202.0002U1
VIA EFS-WEB
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

HOOI, (Alex) Yu Sing

U.S. Application No. **10/582,445**

International Application No.: **PCT/GB2004/005128**

U.S. Filing Date: **September 25, 2006**

International Filing Date: **10 December 2004**

FOR: **SANITARY PRODUCT**

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) Art Unit: **3761**
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) Examiner: **Karin M. Reichle**
)

) Confirmation No.: **7585**
)

AMENDMENT AND RESPONSE

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BALLARD SPAHR LLP

Customer Number 23859

Sir:

In response to the Office Action dated January 27, 2010, please amend the application as follows:

Amendments to the Specification are reflected on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks begin on page 7 of this paper.

A substitute Abstract is attached hereto as an Appendix.

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AMENDMENTS TO THE SPECIFICATION

Please amend the Specification as follows:

On page 7 of the specification, please replace the paragraph beginning at line 16 with the following:

Nonetheless, the sheath should be able to receive a finger, which is likely to have roughly the same or a slightly larger diameter than a small conventional tampon. It is therefore particularly preferred that the The sheath is therefore resiliently expandable in a radial direction to receive a finger during insertion of the product into the vagina. For example, the sheath may be elastic in (only) a circumferential direction, which allows for radial expansion. (Significant elasticity in a longitudinal direction may be undesirable as it can lead to misplacement of the plug). More specifically, the absorbent and liquid impermeable tubes may be elastic in a circumferential direction.

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This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims

1. (Previously presented) A sanitary product for insertion into a human vagina, the product comprising an internally wearable absorbent plug and an externally wearable absorbent pad joined to one another by a sheath that opens through the pad and is resiliently expandable in a radial direction, but not in a longitudinal direction, such that a wearer's finger can be received in the sheath to assist insertion.
2. (Previously presented) The sanitary product of claim 1, wherein the sheath is liquid impermeable in a direction from the outside of the sheath to the inside of the sheath.
3. (Previously presented) The sanitary product of claim 1, wherein the sheath comprises a tube of liquid impermeable material.
4. (Previously presented) The sanitary product of claim 1, wherein the pad comprises an absorbent layer and a liquid impermeable backing sheet.
5. (Previously presented) The sanitary product of claim 3, wherein the pad comprises an absorbent layer and a liquid impermeable backing sheet and the backing sheet is integral with the liquid impermeable material of the sheath.

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6. (Previously presented) The sanitary product of claim 1, wherein the sheath passes liquid along its length from the plug to the pad.

7. (Previously presented) The sanitary product of claim 1, wherein the sheath comprises a tube of absorbent material.

8. (Previously presented) The sanitary product of claim 1, wherein the sheath comprises a tube of liquid impermeable material inside a tube of absorbent material.

9. (Previously presented) The sanitary product of claim 1, wherein the sheath is flexible.

10. (Previously presented) The sanitary product of claim 1, wherein the sheath has a smaller diameter than that of the plug.

11. (Cancelled)

12. (Previously presented) The sanitary product of claim 1, wherein the sheath extends for substantially 2.5 cm between an end of the plug and a surface of the pad closest to the plug.

13. (Previously presented) The sanitary product of claim 1, further comprising a cord attached to the plug to assist removal of the plug from the vagina.

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14. (Original) The sanitary product of claim 13, wherein the cord extends along the inside of the sheath.

15. (Previously presented) The sanitary product of claim 10, wherein the plug is substantially 4cm in length or less and 2cm in diameter or less.

16. – 18. (Cancelled)

19. (Previously presented). The sanitary product of claim 1, wherein the plug is substantially 3.5cm in length or less and 1.5cm in diameter or less.

20. (Previously presented) The sanitary product of claim 1, wherein the plug is substantially 3.5cm in length and 1.5cm in diameter.

21. (Previously presented) The sanitary product of claim 1, wherein the pad has the shape of a flat ellipse with one end wider than the other.

22. (Previously presented) The sanitary product of claim 1, wherein the pad is substantially 6.5cm long and 5.5cm wide.

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23. (Previously presented) The sanitary product of claim 1, wherein the pad is substantially 0.5cm thick.

24. (Cancelled)

25. (Cancelled)

26. (Cancelled)

27. (New) A method of using a sanitary product according to claim 1 comprising inserting a finger into the sheath and pushing the plug into the vaginal orifice.

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REMARKS

Claims 11 and 25 have been cancelled. New claim 27 has been added. Claims 1-10, 12-15, 19-23 and 27 are now pending in the application. Reexamination and reconsideration of the claims, in view of the amendments and discussion below, are respectfully requested.

In response to the objection to the drawings under 37 C.F.R. 1.84(a), a new Figure 5 is submitted, along with renumbered pages for Figures 1-4. In response to the examiner's objections, Figure 5 now shows the layers 3b-4b as cross-hatched to indicate that these layers are also in section, and includes a cut-line at the upper end of the layers 4a-4b of the sheath 4 to indicate where the partial section terminates. **[Examiner Note – this is an area I would like to discuss with you, to make sure I fully understand your objections to the drawing. One suggestion I have is to add a section line to Fig. 4, to indicate where the section of Fig. 5 is taken. See attached informal mark-ups for discussion.]**

The examiner objected to the Abstract as using unnecessary or legal terminology. The attached replacement Abstract is submitted in response.

The examiner objected to the disclosure because the description of the invention needs to be consistent with the drawings. It is submitted that Figure 5 submitted with this response overcomes this objection.

The examiner also objected to the disclosure as being either internally inconsistent or otherwise not supportive of the previous amendment to claim 1. First, Applicant desires to point out that the phrase added to claim 1 in the prior amendment was: "and is resiliently expandable in a radial direction, but not in a longitudinal direction." Support for this amendment is found in the original specification at page 7, lines 18-22, as previously referenced.

The examiner's concerns with the inconsistencies between the use of "expandable in a radial direction" and references in the specification to "elastic in a circumferential direction"

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seem to be inapposite. Applicant states that in order for a cylindrical tube to be expandable in a radial direction it is at least desirable, if not necessary, that the tube be elastic circumferentially (that is, in a circumferential direction). **[[This is another area I want to make sure I understand your position and to discuss. The terms "radial" and "circumferentially" are used interchangeably, but we are open to using only "radial" if that is necessary to achieve allowance.]]**

The examiner objected to the amendment to the specification as adding new matter, with specific reference to the amendments to page 4, line 13, and to page 7, line 16. As discussed above, it is submitted that the prior language at page 7, lines 16-24, supports the amendment to page 4, lines 13-17. Regarding the objection to the amendment to page 7, line 16, the amendment to the specification herein restores that paragraph to the original status.

The examiner objected to claims 9, 11, and 25 as being substantial duplicates of claim 1. Applicant has cancelled claims 11 and 25. However, with regard to claim 9, Applicant submits that "flexible" as claimed in claim 9 is not the same as "expandable" in claim 1, and, therefore, the objection to claim 9 on this basis should be withdrawn.

The examiner rejected the claims under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It is submitted that this rejection should be withdrawn on the basis of the discussion above regarding the use of the terms "radial" and "circumferential."

The examiner also provisionally rejected the claims on the ground of nonstatutory obviousness-type double patenting over claims 1-28 of Application No. 11/920481. Applicant respectfully submits that until such time that the Examiner finds allowable subject matter, a complete determination regarding the merits of this provisional double patenting rejection cannot be made. Furthermore, since the present application has the earlier filing date, it appears that the disclaimer, if required, should be filed in Application No. 11/920481 if and when the claims in

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that application are allowed. However, if the examiner holds that a disclaimer is required in the present case, Applicant will file the required disclaimer at that time.

Based on these arguments, claim 1 should be allowable. Since the remaining claims are all dependent, directly or indirectly, on claim 1, they should also be allowable. Therefore, early allowance of all pending claims is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF EFS-WEB SUBMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any item indicated as attached or included, is being transmitted via EFS-Web transmission on the date indicated below.

Jo Anne Pysan

Date

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APPENDIX

ABSTRACT

A sanitary product 1 for use by women for the absorption of menstrual has a plug 2 and a pad 3 joined by a sheath 4. The plug 2 is substantially cylindrical so that it fits comfortably in a vaginal cavity. The pad 3 remains outside the vaginal cavity, but has an absorbent layer on an inward side 9 proximal to the plug 2 and a liquid impermeable layer on an outward side 10. The sheath 4 includes a tube of absorbent material for drawing excess menstrual fluid from the plug 2 to the pad 3 and has a layer of liquid impermeable material on its inside surface. It extends from an outward end 6 of the plug 2, proximal to the pad 3, both to and through the pad 3. In use, a wearer can insert a finger into the sheath 4 from the outward side 10 of the pad 3 assist with insertion of the plug 2 into the vaginal cavity.